

REMARKS

The following is intended as a full and complete response to the Office Action mailed on September 22, 2003. Claims 1-20 were examined. The Examiner rejected claims 1-12 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Huber, et al. in view of Wagner. The Examiner rejected claims 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Huber, et al. in view of Riza, et al.

Claims 13 and 16 have been amended to correct informalities.

Claim Objections

The Examiner has objected to claim 13 due to informalities. Accordingly, Applicant has amended claim 13 and therefore respectfully requests the rejection be removed.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-12 and 16-20 as being unpatentable over Huber, et al. (U.S. Patent 5,559,622) in view of Wagner (U.S. Patent 4,261,638). In response, Applicant respectfully traverses this rejection. The Examiner has failed to provide a *prima facie* case of obviousness.

Wagner clearly states that the optical switch disclosed therein eliminates “the need for a refractive element, such as a lens” to provide “a structure in which the output signal is independent of wavelength and index of refraction” (See Abstract). As the forgoing citation illustrates, Wagner expressly teaches away from using an additional lens, such as a focusing lens or a collimator lens, for purposes of providing an optical switch arrangement in a switchable two-fiber system as claimed by Applicant. For this reason, one ordinary skilled in the art would have no motivation to replace the optical switch in the circuit arrangement disclosed in Huber, et al. with the optical switch disclosed in Wagner to obtain the switchable two-fiber system having a focusing lens disposed between the reflector and the optical detector (claim 1) and a collimator lens disposed between the reflector and various optical fibers (claims 2 and 3) as claimed by Applicant. Without a motivation to combine, Huber, et al. and/or Wagner cannot render claims 1-12 and 16-20 obvious.

In addition, the Examiner explains in the rejection: “Huber, et al. in view of Wagner does not specifically disclose as claimed: a focusing lens, collimator lens, apertures, second reflector fixed to the reflector, a monitor light, a monitor detector or an actuator. It would

have been obvious to a person of ordinary skill in the art at the time the invention was made to provide such components in the apparatus of Huber, et al. in view of Wagner".

MPEP 2143.03 provides:

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Further, MPEP 2144.04(B) provides:

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). ... If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

Finally, MPEP 2144.04(C) provides:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

As correctly recognized by the Examiner, neither Huber, et al. nor Wagner discloses a focusing lens, collimator lens, apertures, second reflector fixed to the reflector, a monitor light, a monitor detector or an actuator. Further, the Examiner has provided no support for his assertion that it would be obvious to one of ordinary skill to provide each component, as

required by 35 U.S.C. § 103. As set forth above, the Examiner cannot merely state that it would have been obvious to “provide a lens” or to “provide a collimator lens” with no evidence as to why it would be obvious to do so. A general rationale that it would “improve detection” or “improve optical coupling” without some teaching in the prior art is a rationale based on impermissible hindsight and is not permitted within the confines of 35 U.S.C. § 103. For these reasons, the Examiner has failed to make a *prima facia* showing of obviousness and, therefore, claims 1-12 and 16-20 are patentable over Huber, et al. in view of Wagner. Thus, Applicant respectfully submits that claims 1-12 and 16-20 are in condition for allowance and requests withdrawal of the § 103(a) rejection.

The Examiner rejected claims 13-15 as being unpatentable over Huber, et al. in view of Riza, et al. (U.S. Patent 5,208,880).

In the rejection, the Examiner explains: “Huber, et al. in view of Riza, et al. does not specifically disclose as claimed a focusing lens or collimator lens. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide such components in the apparatus of Huber, et al. in view of Riza, et al.”. Applicant respectfully traverses this rejection.

As correctly recognized by the Examiner, neither Huber, et al. nor Riza, et al. discloses a focusing lens or a collimator lens. Further, the Examiner has provided no support for his assertion that it would be obvious to one of ordinary skill to provide the each component, as required by 35 U.S.C. § 103, but only a rationale based on impermissible hindsight gleaned from a knowledge of Applicants’ disclosed invention. For similar reasons as set forth above, the Examiner has failed to make a *prima facia* showing of obviousness and, therefore, claims 13-15 are patentable over Huber, et al. in view of Riza, et al. Thus, Applicant respectfully submits that claims 13-15 are in condition for allowance and requests withdrawal of the §103(a) rejection.